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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,073	02/15/2001	Yoshinori Ito	35.C15126	3810

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,073

Applicant(s)

ITO, YOSHINORI

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,13,14,16 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,13,14,16 and 33-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-8, 13, 14, 16 and 33-37 have been examined.

Response to Amendments/Arguments

2. The Examiner apologizes for the typographical error ("Claim 33 recites ... in the claims") in the previous Office Action. Specifically, the 112 rejection applied to claim 33 also apply to claims 36 and as they recite similar language (i.e. the exterior"), while claims 34 and 35 are rejected as they depend from claim 33.

Regarding Applicant's use of conditional language, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP, Chapter 2106, section II, C). Therefore, in order to read on the conditional language of claims 33, 36 and 37 an obvious modification would be to do nothing or in light of the teachings of Holmes et al. to not embed the payment information in the protected content thereby allowing a user to access protected content.

Applicant's arguments with respect to claims 1-8, 13, 14, 16 and 33-37 have been considered but are moot in view of the new ground(s) of rejection.

In response to the non-elected claims:

This application contains claims 18-32 drawn to an invention nonelected without traverse in Applicant's Response to Examiner's Office Action dated 11 September 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8, 13, 14 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 13, 14, and 16 recite the limitation of adding "payment information" to an image. The Specification, however, only refers to adding identification information (Specification, paragraphs 141, 178, 179, 181, 183 and 184).

Claims 2-8 are also rejected as they depend from claim 1.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 8, 9-13, 15, 17 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 1 recites the limitation "the payment information" in line 5. Claims 13, 14 and 16 recite a similar limitation. There is insufficient antecedent basis for this limitation in the claims.

Claims 2-7 are also rejected as they depend from claim 1.

- b. Claims 1, 13, 14, and 16 recite the limitation of adding "payment information" to an image. The Specification, however, only refers to adding identification information (Specification, paragraphs 141, 178, 179, 181, 183 and 184).

Claims 2-7 are also rejected as they depend from claim 1.

c. Claim 8 recites "wherein said addition means adds information specific to the apparatus". Claim 1, from which claim 8 depends, recites an image processing apparatus and an information communication apparatus, therefore it's not clear to which apparatus claim 8 is referring.

d. Claims 33 recites the limitation "to the exterior" in line 5. Claims 36 and 37 recite similar language. There is insufficient antecedent basis for this limitation in the claims.

Claims 34 and 35 are also rejected as they depend from claim 33.

e. Claim 33, 36 and 37 recite conditional language. Specifically, the claims recite embedding information "if" predetermined information is effective without providing one of ordinary skill how the apparatus is to perform in the alternative case. Therefore, the scope of the claims are not clear ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous", *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-7, 14, 16, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of Srinivasan, U.S. Patent No. 6,460,076.

As per claims 1, 3, 5, 7, 14, 16, and 33-37, Holmes et al. teach an image processing apparatus comprising:

- first input means for entering payment information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32)
- second input means for entering an image (column 4, lines 58-64)
- addition means for adding said information on the addressee of fee billing to said image in a manner not easily recognizable to human eyes and outputting said image (column 6, lines 51-59)
- information such as information that specifies credit card company and credit card user (column 5, lines 25-32)
- first input means for entering information for enabling activation (column 5, lines 60-66) and second input means also for enabling

activation in response to the entering of enabling information

(abstract)

- discrimination means for discriminating whether said image is a specified image and control means for controlling the addition by said addition means based on the result of discrimination by discrimination means (column 5, lines 25-58)
- inquiry means for authenticating predetermined information by communicating through a communication channel with an external server (column 5, lines 32-44)

Regarding “adding means” or more generally the process for adding information to an entered image, this is taught by Holmes et al. as a user does not see, for example, the computational process by which bits of an image are changed so that payment information (column 5, lines 25-31) is added to the image. The user only becomes aware of the computer’s actions (e.g. adding means) after the fact such as when the user attempts to access protected content (figure 2). Holmes et al. inherently or at least suggests a computer interface or GUI for entering payment information (column 5, lines 25-28). Similarly, Holmes et al. require a user to re-enter the information in order to access the protected content (column 6, lines 4-11). Therefore, it is inherent to Holmes et al. or at least Holmes et al. clearly suggest the deletion of the entered payment information. Otherwise, system security and/or user payment information is comprised (column 5, lines

25-28; column 6, lines 4-11 and 51-59). Holmes et al., however, does not specifically recite when the information is deleted. Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). Therefore, it would have been obvious to one of ordinary skill to the delete payment information of Holmes et al. after it has been used (e.g. entered into an image) in order to save memory ('076, column 5, lines 45-50) or maintain a secure system by preventing the payment information of previous users to be displayed to new users ('108, column 5, lines 25-31; column 6, lines 51-60).

As per claim 4, Holmes et al. teach a first input means for entering credit card information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32). Holmes et al. do not teach debit card information. However, it is well known to those of ordinary skill in electronic commerce to pay for goods and services using a debit card, therefore, it would have been obvious to allow content consumers to pay for content using a debit card (figure 2).

As per claim 6, Holmes et al. teach outputting content using a computer (figure 2). Computers that control output based on paper size or color are old and well known.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 and Srinivasan, U.S. Patent No. 6,460,076 in view of May, U.S. Patent No. 6,021,492.

As per claim 2, Holmes et al. teach a system for protecting content using a communication apparatus (i.e. plug-in embodied in a computer) that controls the use of software on a user computer (column 5, lines 15-53). Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). However, neither Holmes et al. nor Srinivasan specifically recite outputting information to the communication apparatus based on an outputted image. May teaches content protection by limiting the number of access a user has to content (figures 11-14). Specifically, May teaches outputting information to a content control module based on outputted content (figures 10-15; column/line 9/58-11/67). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes et al., Srinivasan, and May in order to allow content creators to allow users to try content before purchasing and to provide users with other compensatable methods for accessing content other than buying ('492, column/line 9/58-11/52).

10. Claims 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 and Srinivasan, U.S. Patent No. 6,460,076 as applied to claim 1 above, and in further view of, Chou et al., U.S. Patent No. 5,337,357.

As per claim 8, Holmes et al. teach a first input means for entering information from said information communication apparatus (column 5, lines 25-32). Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). However, neither Holmes et al. nor Srinivasan specifically recite entering apparatus information. Chou et al. teach a method for protecting content using input information such as an apparatus identifier (abstract; figure 1). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes et al., Srinivasan and Chou et al. in order to use personal information such as user computer-specific information to protect content ('108, column 5, lines 29-31; '357, figure 1).

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of Krishnan et al., U.S. Patent No. 6,073,124 and Srinivasan, U.S. Patent No. 6,460,076.

As per claim 13, Holmes et al. teach an image processing apparatus comprising:

- first input means for entering information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32)
- second input means for entering an image (column 4, lines 58-64)
- addition means for adding said information on the addressee of fee billing to said image in a manner not easily recognizable to human eyes and outputting said image (column 6, lines 51-59)

Regarding "adding means" or more generally the process for adding information to an entered image, this is taught by Holmes et al. as a user does not see, for example, the computational process by which bits of an image are changed so that payment information (column 5, lines 25-31) is added to the image. The user only becomes aware of the computer's actions (e.g. adding means) after the fact such as when the user attempts to access protected content (figure 2). Holmes et al. inherently or at least suggests a computer interface or GUI for entering payment information (column 5, lines 25-28). Similarly, Holmes et al. require a user to re-enter the information in order to access the protected content (column 6, lines 4-11). Therefore, it is inherent to Holmes et al. or at least Holmes et al. clearly suggest the deletion of the entered payment information. Otherwise, system security and/or user payment information is comprised (column 5, lines

25-28; column 6, lines 4-11 and 51-59). However, Holmes et al. do not specifically recite a first input means for entering information on an addressee of fee billing (e.g. credit card information specifying a company and a user) and a password. Krishnan et al. teach an information communication apparatus comprising:

- a third input means for entering information on an addressee of fee billing (e.g. credit card information specifying a company and a user) and a password (figures 14 and 15)
- third output means for outputting said information to an external server (figures 3 and 12; column 19, lines 45-60; column/line 20/64-21/2)
- fourth output means for outputting to an image processing apparatus information on the address of fee billing according to a result of identification on said information on the addressee of fee billing and said password in said external server (figure 12; column 19, lines 63-67)
- fourth input means for entering information and fifth output means for outputting information to said external server (figure 17)

However, neither Holmes et al. nor Krishnan et al. specifically recite when the information is deleted. Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). Therefore, it would have been obvious to one of ordinary skill to modify the teachings of Holmes et al., with the authentication

method of Krishnan et al. and the payment information processing of Srinivasan in order protect buyers and sellers from fraud ('108, column 5, lines 25-31 and 34-44; column 6, lines 51-60; '124, figures 12-17, column 19, lines 20-67).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

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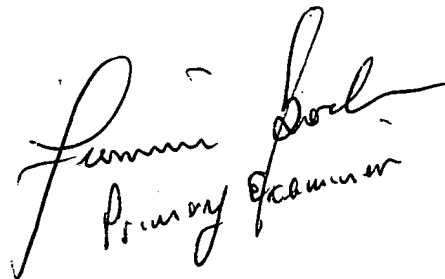
(703) 872-9306 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

June 30, 2005

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", with the word "Primary Examiner" written below it in a smaller, cursive script.